



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,366	04/17/2001	Cheng-Shing Lai	LAIC3001/EM/6698	5773

7590 05/21/2004
BACON & THOMAS, PLLC
625 Slaters Lane 4th Floor
Alexandria, VA 22314-1176

EXAMINER
NGUYEN, LEE

ART UNIT	PAPER NUMBER
2682	2

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,366

Applicant(s)

LAI ET AL.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Papineau et al. (US 2002/0090931).

Regarding claim 1, Papineau teaches a method for selecting to activate a personal digital assistant (PDA) or a mobile phone in an electronic device comprising a menu containing a PDA option and a mobile phone option such that when said device is enabled, said PDA or said mobile phone option is selectable for generating a signal indicating said selection, and a central processing unit (CPU) for showing a prompt of said selected PDA option or said mobile phone option for use after receiving said signal, see [0022] – [0024].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papineau et al. in view of Kraft (US 6,309,305).

Regarding claim 2, Papineau further teaches the step of displaying a menu containing a PDA option and a mobile phone option for selection by

activating a display means after powered on [0023] – [0024]; selecting one of said options by clicking through an activated input means [0024]; and inherently determining by said CPU 106 (fig. 2) which of said PDA option and said mobile phone option is selected (see [0023]-[0024]) and if said mobile phone option is selected, said CPU inherently reading a program stored in a mobile phone read only memory 218 for showing a prompt of said mobile phone, closing a switch means for commanding a transceiver means through a control circuit 218, transmitting messages from an antenna or received by said antenna 201. Papineau does not explicitly teach operating said device for reading data from a random access memory (RAM) or writing data into said RAM. In an analogous art, Kraft teaches that RAM can be used for read/write text message (col. 2, lines 54-67 and col. 4, lines 4-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the RAM of Kraft to the apparatus of Papineau so that programs as well as data for applications can be accessed (col. 4, lines 6-15).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papineau et al. in view of Kraft (US 6,309,305) as applied to claim 2 above and further in view of Nguyen (US 5,797,089).


Regarding claim 3, Papineau as modified inherently teaches that said CPU 106 (fig. 2) reading a program stored in a PDA ROM if said PDA option is selected for showing a prompt of said PDA, controlling said selected PDA option by said control circuit (see [0020]). Papineau as modified fails to teach operating said device for reading data from said RAM or writing data into said RAM. In other words, Papineau as modified fails to teach that the same RAM is used for both the mobile phone and the PDA. In an analogous art, Nguyen teaches that the same RAM can be commonly accessed by both the PDA and the mobile telephone (col. 4, lines 35-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Nguyen to the apparatus of Papineau in order to save space and cost of an extra RAM.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone

number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5/13/04
LEE NGUYEN
Primary Examiner
Art Unit 2682